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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,060	06/01/2001	Stanton M. Keeler	M-11585 US	2297

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MacPherson Kwok Chen & Heid LLP
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San Jose, CA 95110

EXAMINER

TORRES, JOSEPH D

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,060

Applicant(s)

KEELER, STANTON M.

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20041018</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 16-20, drawn to Error Correction for an Optical Disk Having a Transparent Layer, classified in class 714, subclass 769.
- II. Claims 25-28, drawn to Error Correction for an Optical Disk Having No Transparent Layer, classified in class 714, subclass 769.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I, Error Correction for an Optical Disk Having a Transparent Layer, and Group II, Error Correction for an Optical Disk Having No Transparent Layer, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions cannot be used together since an optical disk having no transparent layer is a completely different device from an optical disk having a transparent layer.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jonathan Hallman on 11/18/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 16-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Arguments

Applicant's arguments filed 07/23/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "Finkelstein does not disclose the use of a removable first surface disk" has not been given patentable weight because "first surface disk" only appears in the preamble (Note: "removable" does not appear anywhere in the claims). A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "**removable** first surface disk" [Emphasis Added]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner disagrees with the applicant and maintains all rejections of claims 16-20 and 25-28 (Note: claims 25-28 are identical to previously examined claims 21-24). All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 16-20 and 25-28 are not patentably distinct or non-obvious over the prior art of record in view of the references, Nakatsuji, Fumio et al. (US 6332206 B1, hereafter referred to as Nakatsuji), Finkelstein; Blair I. et al. (US 5392262 A, hereafter referred to as Finkelstein), ECMA-279 (ECMA-279 standard for DVD-Recordable Disks, November 1998) and Norton; James R. et al. (US 5283159 A, hereafter referred to as Norton) as applied in the last office action, filed 04/30/2004. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuji, Fumio et al. (US 6332206 B1, hereafter referred to as Nakatsuji) in view of Finkelstein; Blair I. et al. (US 5392262 A, hereafter referred to as Finkelstein). See the Non-Final Action filed 04/30/2004 for detailed action of prior rejections.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuji, Fumio et al. (US 6332206 B1, hereafter referred to as Nakatsuji) and Finkelstein; Blair I. et al. (US 5392262 A, hereafter referred to as Finkelstein) in view of ECMA-279 (ECMA-279 standard for DVD-Recordable Disks, November 1998). See the Non-Final Action filed 04/30/2004 for detailed action of prior rejections.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuji, Fumio et al. (US 6332206 B1, hereafter referred to as Nakatsuji) in view of Norton; James R. et al. (US 5283159 A, hereafter referred to as Finkelstein).

See rejection to claim 21 in the Non-Final Action filed 04/30/2004 for detailed action of prior rejections (Note: claim 25 is identical to previously examined claim 21).

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsuji, Fumio et al. (US 6332206 B1, hereafter referred to as Nakatsuji) and Norton; James R. et al. (US 5283159 A, hereafter referred to as Finkelstein) in view of ECMA-279 (ECMA-279 standard for DVD-Recordable Disks, November 1998).

See rejection to claims 22-24 in the Non-Final Action filed 04/30/2004 for detailed action of prior rejections (Note: claims 26-28 are identical to previously examined claims 22-24).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph D. Torres, PhD
Primary Examiner
Art Unit 2133

